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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,301	11/13/2001	Jane Childs	CHA920010014US1	5355

7590 03/08/2005
James E. Murray
69 South Gate Drive
Poughkeepsie, NY 12601

EXAMINER

JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,301

Applicant(s)

CHILDS ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/13/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The oath is not signed and dated by all inventors.

Claim Objections

2. Claims 1 and 8 are objected to because of the following informalities: the recitation "a on-line" in the preamble should be changed to --an on-line --. Further the recitation "said software" should be replaced by "said method comprising." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "the merchants products" lacks proper antecedent basis.

In claim 1, the recitations "the number of hits" and "in the merchants database" lack proper antecedent basis.

Further in claim 1, the recitation "the merchants marketing strategy" lacks proper antecedent basis. Also, the recitations "the customer that presents the product" and "the initial ranking and the modification" lack proper antecedent basis.

In claim 2, the recitation "the presentation" lacks proper antecedent basis.

In claim 6, the recitation "the highest ranked" lacks proper antecedent basis.

Further, the recitation "of the SWF Factor" lacks proper antecedent basis.

Claim 7 is improperly written.

In claim 8, the recitation "the merchants products" lacks proper antecedent basis.

In claim 8, the recitation "the number of hits" lacks proper antecedent basis.

Further in claim 8, the recitation "the merchants marketing strategy" lacks proper antecedent basis. Also, the recitation "the customer that presents the product" lacks proper antecedent basis.

In claim 11, the term "F" renders the claim indefinite since it is not properly defined. Further, the recitation "to the SBW weighting factor" is unclear. What does SBW stand for?

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

Art Unit: 3627

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/120,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications achieved the same end result of ranking merchants products based on number of hits to product description in merchants database and merchants marketing strategy.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3627

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegel et al. (6,466,918), in view of Nabe et al. (2002/0049701 A1)

Spiegel discloses a method for enabling an on-line merchant to tailor a response to a shopper's on-line interrogation and computer software embodied in a computer usable medium with the steps of:

ranking the merchants products at least partially based on the number of hits (based on popularity) to product descriptions in the merchants database on-line requests of the shopper specifying characteristics of a product desired by the shopper (col. 2, lines 5-25); modifying the ranking of at least one of the merchants products ranked by the ranking (via increasing the rating count), and transmission software for providing a presentation of products to the customer that presents the products in order of rank determined by both the initial ranking and the modification of at least one of the

Art Unit: 3627

merchants products (as illustrated in figures 5 and 6). Spiegel further discloses using other weighting factors in the ranking for taking into account other adjustments of tailor the presentation where the other ranking factors include factors for the customer's buying preferences and product popularity (col. 7, line 59 – col. 8 lines 7). Spiegel also discloses limiting the highest ranked of the group for insertion into the presentation prior to application of the SWF Factor (via selection of the most popular node col. 2, lines 37-45), and transmitting the presentation on the Internet intermixed with products of other merchants where the products of all merchants is presented to the shopper in order of rank (as illustrated in Figures 1A and 2).

However, fails to explicitly disclose that the modification is by a factor based on the merchants marketing strategy and modifying the ranking of a group of the merchants products based on the merchants marketing strategy.

Nabe et al. discloses the concept of modeling customer data using tool to model data within a relational database and scoring the model data. Nabe further discloses using marketing strategies selecting a particular group and directing marketing effort to that selected group. From this teaching of Nabe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the scoring of popular items in Spiegel to include the marketing strategies taught by Nabe in order to list of potential profitable accounts, per customer and/or per product, in a rank ordering from a maximum profit to a zero profit versus cost.

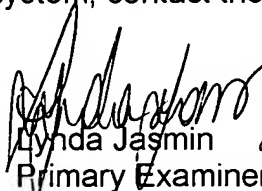
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ortega disclosing exposing popular items categories within a catalog on an online merchant. Hey disclosing the concept of recommending items. Linden et al. disclosing an item-by-item similarity mapping.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
3/5/05